

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Malcolm M. Smith
Serial No:	09/752,876
Date Filed:	December 28, 2000
Confirmation No.	9414
Group Art Unit:	2616
Examiner:	Clemence S. Han
Title:	DISTRIBUTION OF PACKETS TO FOREIGN AGENTS USING MULTICAST PROTOCOLS

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

REMARKS

Applicant contends that the rejections of Claims 1-32 contain clear legal and factual deficiencies, as described below. In the Final Office Action dated May 3, 2006 (“*Final Office Action*”), the Examiner rejected Claims 1-3, 5-12, 14-20, 22, 23, and 25-31 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,522,880 issued to Verma, et al. (“*Verma*”), in view of U.S. Patent Application Publication No. 2001/0036834 issued to Das, et al. (“*Das*”). Also, the Examiner rejected Claims 4, 13, 21, 24, and 32 under 35 U.S.C. §103(a) as unpatentable over *Verma* in view of *Das*, and further in view of U.S. Patent No. 6,070,075 issued to Kim (“*Kim*”). Applicant requests a finding that these rejections are improper and an allowance of these claims.

Initially, Applicant notes that *Das* relies on a provisional application for an earlier effective filing date (the “*Das Provisional*”). While the filing date of the *Das Provisional* predates Applicant’s filing date, *Das*’s filing date falls after Applicant’s filing date. Therefore, the Examiner may not rely on the teachings of *Das* unless those same teachings appear in the *Das Provisional*.

1. The *Verma-Das Provisional* combination fails to teach or suggest all limitations of the claims.

Independent Claim 1 is allowable because *Verma* and the *Das Provisional*, whether taken alone or in combination, do not teach or suggest, at least, “[a] foreign agent operable . . . to register for a multicast group identified by the multicast address.” As teaching these claimed aspects, the Advisory Action dated July 14, 2006 (“*Advisory Action*”) and *Final Office Action* both point to the beginning paragraph in the first column of page 8 of the *Das Provisional*. *Advisory Action*, p. 2; *Final Office Action*, p. 9.

In the cited paragraph, the *Das Provisional*’s mobile node decides to change foreign agents, and the mobile node sends a message to its current foreign agent, who relays the message to the mobility agent. *Das Provisional*, p. 8, col. 1, ll. 1-18. The mobility agent determines the multicast group that identifies the neighbors of the current foreign agent so that subsequent packets may be forwarded to multicast group members. *Id.* The *Das Provisional* makes clear that “the membership of this multicast group is always stable” because the set of neighboring subnets is “well-established.” *Id.* at ll. 16-18.

Thus, the *Das Provisional* teaches pre-established, stable multicast groups. However, it fails to teach or suggest a foreign agent operable to register for a multicast group identified by the multicast address, as required by Claim 1. In fact, the cited portion of the *Das Provisional* fails to teach or suggest any device operable to register for a multicast group identified by the multicast address. *Verma* fails to remedy the deficiencies of the *Das Provisional*.

Applicant thus respectfully submits that *Verma* and *Das*, whether taken alone or in combination, fail to teach or suggest every element of Claim 1. Likewise, independent Claims 6, 14, 22, and 25 include limitations that, for similar reasons, are not taught or suggested by the references. Dependent Claims 2-3, 5, 7-12, 15-20, 23, and 26-31 are allowable because they incorporate the limitations of their respective independent claims. Accordingly, Applicant respectfully requests reconsideration and allowance of Claims 1-3, 5-12, 14-20, 22, 23, and 25-31.

Moreover, Applicant submits that the *Verma-Das-Kim* combination fails to teach or suggest every element of dependent Claims 4, 13, 21, 24, and 32 because *Verma* and *Das* fail to teach or suggest all limitations of their corresponding independent claims and *Kim* fails to remedy the deficiencies of *Verma* and *Das*. Accordingly, Applicant respectfully requests reconsideration and allowance of Claims 4, 13, 21, 24, and 32.

2. The *Das Provisional* teaches away from the claims, and, thus, the use of *Das* under 35 U.S.C. § 103 is improper.

The use of *Das* under 35 U.S.C. § 103 is improper because the *Das Provisional*, upon which the Examiner must rely given the filing date, teaches away from the claims. *See In re Kumar*, 418 F.3d 1361, 1368, 76 U.S.P.Q.2d 1048, 1052 (Fed. Cir. 2005); *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983). Applicant's independent Claim 1 requires: "[a] foreign agent operable . . . to register for a multicast group identified by the multicast address." However, the *Das Provisional* technique avoids dynamic formation of multicast groups and any registrations for multicast groups.

As noted previously, the *Das Provisional* specifically states that the set of neighboring subnets is "well-established" and that the membership of the multicast group "is always stable." *Das Provisional*, p. 8, col. 1, ll. 16-18. After identifying the multicast groups as always stable, the *Das Provisional* even describes the advantages of this stable multicast

group: “We thus avoid the latencies associated with the dynamic formation of this group (e.g., latencies involved with Join messages in typical IP multicasting protocols).” *Id.* at ll. 18-20. The *Das Provisional* also states that its “scheme does not require group members to join and leave the group dynamically.” *Id.* at p. 7, col. 2, ll. 40-42.

Applicant thus respectfully submits that the *Das Provisional* teaches away from Claim 1. Also, the *Das Provisional* teaches away from independent Claims 6, 14, 22, and 25 for substantially similar reasons. Because the *Das Provisional* teaches away from limitations of Claims 1, 6, 14, 22, and 25, the use of *Das* under § 103 is improper. Accordingly, Applicant respectfully requests reconsideration and allowance of Claims 1, 6, 14, 22, and 25, and their respective dependent claims.

CONCLUSION

As the rejection of Claims 1-32 contains clear deficiencies, Applicant respectfully requests a finding of allowance of Claims 1-32. If the PTO deems that an interview is appropriate, Applicant would appreciate the opportunity for such an interview. To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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